

## REMARKS

### INTRODUCTION:

As described in the preceding section, no claims have been amended, added or cancelled.

Claims 1- 20 are pending and under consideration. Claims 1, 10, 15 and 18 are independent claims. Reconsideration of the claims is respectfully requested in view of the following remarks.

### REJECTIONS UNDER 35 USC § 103:

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Publication Number 2002-22961 by Noritomo ("Noritomo") in view of US Patent Application Number 2002/22961 by Luby et al. ("Luby"). The rejections are respectfully traversed.

Independent claim 1 recites at least the following:

an image forming unit to change a time-out value based on the wireless reception sensitivity information

Noritomo and Luby, alone or in combination, fail to suggest or disclose at least all of the above-recited features.

The Office Action asserts at page 3, lines 6-9 that Noritomo discloses all of the above-recited features. Specifically, the Office Action states:

"the time required for the transmission of the data to be completely transmitted is calculated and it can be re-calculated through the transmission. See Paragraphs 10 and 12-13."

Even assuming for the sake of argument that the Office Action statement is accurate, Applicant respectfully disagrees that Noritomo describes all of the above-recited features because none of the cited portions of Noritomo expressly state that the transmission time is calculated based on the wireless reception sensitivity information. For example, par. [0010] of merely states:

“Also, the information equipment of the present invention is characterized by being further equipped with a means for calculating the time required for transmitting the data to the above-mentioned header; and a means for displaying the required time displayed by said means.”

In addition, paragraph [0012] states:

“Also, the information equipment of the present invention is characterized by being further equipped with a calculation means for calculating the remaining required time during the data transmission...”

It can be seen that neither paragraph of Noritomo expressly states that the transmission time is calculated based on the wireless reception sensitivity information. Applicant traverses on the grounds that one skilled in the art at the time of the invention would have been more likely to interpret the cited portions of Noritomo as calculating the remaining required time during the data transmission *without* consideration of the sensitivity, in particular because of Noritomo’s silence on the matter.

Accordingly, if the rejection is to be maintained, Applicant respectfully requests the Office support the rejection with a specific paragraph number and figure reference, or specifically indicate if an assertion of inherency is being relied upon. If an assertion of inherency is to be relied upon in any future Office Action, Applicant respectfully requests the rejection provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied reference, as required by MPEP 2112 IV. Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office’s position as to these arguments and to clarify the record for appeal.

Still further, Applicant asserts that Noritomo’s calculation of “the time required for the transmission of the data to be completely transmitted,” would not have been interpreted by one skilled in the art at the time of the invention to mean a “time-out value” as recited in claim 1.

Based on the preceding arguments, Applicant asserts that Noritomo fails to suggest or disclose all of the above-recited features of claim 1.

Applicant further submits that Luby fails to cure the deficiencies of Noritomo.

Independent claim 1 further recites at least the following:

stop the reception of a data from the external apparatus as a time-out when a period of non-reception of the data exceeds the time-

out value during the transmission of the image data from the external apparatus

Noritomo and Luby, alone or in combination, fail to suggest or disclose at least all of the above-recited features.

The Office Action notes at page 3, lines 10-13, that Noritomo fails to disclose all of the above-recited features. However, the Office Action seeks to modify Noritomo with Luby, asserting that Luby teaches:

“when the time-out values expires the transmission of the packets/data wirelessly are automatically stopped. See Paragraphs 119.”

Even assuming for the sake of argument that the Office Action statement is accurate, Applicant respectfully disagrees that Luby describes all of the above-recited features because the cited portions of Luby fails to describe “a time out value” that is “based on the wireless reception sensitivity information” as recited in claim 1. Further, Luby fails to describe the transmission of *image* data as recited above. In contrast, Luby generically refers to the transmission of “packet data.”

Based on all of the preceding arguments, Applicant asserts independent claim 1 patentably distinguishes over Noritomo and Luby, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 10, 15, and 18, with potentially differing scope and breadth, are not taught or disclosed by Noritomo and Luby, the rejection should be withdrawn and claims 10, 15, and 18 also allowed.

Further, Applicant respectfully submits that claims 2-9, 11-14, 16-17 and 19-20, which variously depend from independent claims 1, 10, 15, and 18, should be allowable for at least the same reasons as claims 1, 10, 15, and 18, as well as for the additional features recited therein.

Dependent claim 7 recites at least the following:

a controlling unit to change the time-out value in accordance with the time-out information corresponding to the reception sensitivity information stored in the storage unit

Noritomo and Luby, alone or in combination, fail to suggest or disclose at least the above-recited features.

The Office Action asserts that the combination of Noritomo and Luby describe all of the above-recited features. Specifically, the Office Action asserts at page 6, lines 5-10, that Noritomo describes all of the above-recited features because Noritomo describes:

“measurement means that display/output the reception sensitivity of the radio communication/wireless, the digital signal processor, the time required for the transmission of the data is calculated and it can be re-calculated through the transmission.”

Applicant respectfully disagrees because, as argued above with respect to claim 1, the cited portions of Noritomo fail to expressly describe “a time out value” that corresponds to “the wireless reception sensitivity information,” as recited above. Accordingly, the Office Action fails to establish that Noritomo describes all of the recited features.

Moreover, Luby fails to cure the deficiencies of Noritomo.

Accordingly, Applicant respectfully submits that dependent claim 7 patentably distinguishes over Noritomo and Luby, and should be allowable for at least the above-mentioned reasons.

#### Insufficient Reason to Combine Articulated

Applicant respectfully submits that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness: 1) there must be some suggestion or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; 2) there must be a reasonable expectation of success; and 3) the references must either teach or suggest all the claim limitations or the Office must provide a rationale as to why the differences between the claimed invention and the prior art are obvious. MPEP 2141.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Noritomo and Luby, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the documents. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 S Ct 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* at 1396, quoting *In re Kahn*. With respect to the rejection of claim 1, the reasoning provided in the Office Action for combining Noritomo and Luby

states:

“...it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system as suggested by the combination of Noritomo'961 with the teachings of Luby'159 by stopping the reception of a data from the external apparatus as a time-out when a period of non-reception of the data exceeds the time-out value during the transmission of the image data from the external apparatus, in order to improve the system by stopping the reception when need to prevent errors in the data.”

Applicant asserts that the cited rationale for combining Noritomo and Luby is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* Moreover, Applicant respectfully submits that, because the rationale for combining Noritomo and Luby is taken from Applicant's own application, this amounts to an improper hindsight reconstruction of the present invention.

Moreover, *MPEP 2141.01(a)(I)* dictates that to rely on a reference under 35 U.S.C. 103(a), it must be “analogous art.” To establish that art is analogous, the Office Action should address similarities and differences in structure and function of the inventions. *MPEP 2141.01(a)(II)*. A reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. *MPEP 2141.01(a)(I)*. Applicant respectfully asserts that the Office Action fails to establish that Luby is analogous art with respect to the present claims because the rejection is completely silent on this matter. To the contrary, Applicant asserts that Luby is not in the same field of endeavor as the present claims because Luby has significantly different structure and function than the present claims since Luby is directed to techniques for digital content transmission between a server and multiple receivers and not to a wireless image forming apparatus. Further, the Office Action fails to establish that a modification based on Luby logically would have commended itself to an inventor's attention.

Accordingly, one skilled in the art would not have had a reason to combine the teachings of Noritomo with those of Luby, and the rejection under 103(a) is improper. Therefore, Applicant respectfully requests any future rejection provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No: 19-3935.

Respectfully submitted,

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Date: August 4, 2008

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